

REMARKS

The present application includes pending claims 1-23, all of which have been rejected. By this Amendment, claims 2-3, 5-8, 10, 12-13 and 15, and 17-23 have been amended. New claims 24-38 have been added.

The specification was objected to due to missing information in paragraph [0002]. This paragraph has been amended to overcome this objection.

The drawings were objected to because “figure letter ‘C’ of Figure 5 is labeling an incorrect location as mentioned in the specification. According to paragraph [65] of the specification, step ‘C’ should be labeling where ‘the first party 501 accesses the third-party channel 504 using a media guide user interface 502 on a PC 503’.” *See* November 8, 2007 Office Action at page 3. The Applicants have attached a replacement drawing sheet that indicates that step C is proximate the first party 501.

Claims 1-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2003/0115585 (“Barsness”) in view of U.S. 7,065,778 (“Lu”). The Applicants respectfully traverse these rejections for at least the following reasons:

I. The Proposed Combination Of Barsness And Lu Does Not Render Independent Claim 1 Unpatentable

Independent claim 1 recites, in part, “notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic [associated with media]; and refraining from notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media does not match the at least one user-

defined characteristic [associated with media].” The Office Action cites Barsness as disclosing these limitations.

Barsness discloses an “on-screen program guide formatted with viewership information.” *See* Barsness at Abstract. Viewership data is “collected from a plurality of viewers” and then “processed to provide viewership information including viewership interest, viewership growth rates, surfing behavior, and other viewership behavior.” *See id.* The viewership interest may include “group member information such as which members of a group are watching a particular program, group ratings of a program, individual member ratings of a program, and the like.” *See id.* Thus, Barsness discloses a system in which group member information may be formatted on an on-screen program guide.

More specifically, Barsness discloses the following:

In general, viewership data is collected from a plurality of viewers, e.g., cable and satellite receivers. The viewership data is then processed to provide viewership information including viewership interest, viewership growth rates, surfing behavior, and other viewership behavior. The viewership interest may also include group member information such as which members of a group are watching a particular program, group ratings of a program, individual member ratings of a program and the like. The viewership information may then be transmitted back to the viewers and displayed as part of an on-screen program guide or other visual interface.

See id. at [0025].

Barsness discloses that “groups” may be formed.

The group identification (ID) entry 414 and an anonymous flag entry 416 support a group viewership feature. As used herein, a “group” is any number of two or more viewing entities. The purpose of forming a group is to facilitate selective communication of viewership information. The groups may be formed by mutual agreement of each group member. In one embodiment, the groups

are formed by submission of written requests by viewing entities. Alternatively, viewers may contact one another directly to request membership. One particularly efficient method of direction communication is by means of the receivers 104. For example, the receivers 104 may each be configured with e-mail client (or other messaging clients), thereby facilitating communication via a network (e.g., the Internet).

Upon formation of a group, the group is assigned a group identification (ID). Each member of the group is then provided with the group ID, which is stored in the group ID entry 414. In some cases, a group member may desire to remain anonymous. In such cases, the anonymous flag entry 416 may be used to advantage.

Id. at [0048] and [0049]. Thus, Barsness discloses that groups are formed to “facilitate selective communication of viewership information.” *See id.* at [0048]. After the group is formed, each member is provided with the group ID, so that they can gain access to the group. *See id.* at [0049]. Further, “group information may be provided only to group members.” *See id.* at [0057]. An “‘explicit viewer’ may ‘request to see the viewership indicators.’” *See id.* at [0065].

While Barsness discloses that groups may be formed and the group IDs may be used to gain access to the group, Barsness does not describe, teach or suggest that users are notified of consumption of media by other users based on whether pre-defined characteristics for requested media match a user selected characteristic. That is, Barsness does not describe, teach or suggest “notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, **if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic [associated with media];** and refraining from notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, **if the pre-defined set of characteristics for the requested media does not match the at least one user-defined characteristic**

[associated with media],” as recited in claim 1. Lu also does not describe, teach or suggest these limitations. Because neither Barsness, nor Lu, teach these limitations, the combination of the two references cannot, by definition, describe, teach or suggest these limitations. Thus, for at least these reasons, the proposed combination of Barsness and Lu does not render claims 1-10 unpatentable.

II. The Proposed Combination In Relation To Claim 10

With respect to claim 10, the Office Action cites Figure 3 and “paragraph 10, lines 10-38” of Lu as disclosing the relevant limitations. *See* November 8, 2007 Office Action at page 8. The Applicants assume the Office Action means “column 10, lines 10-38.”

The Applicants respectfully submit, however, that there is nothing in Figure 3 of Lu that describes, teaches or suggests “keeping a record of the notifying [the at least a second user of the consumption of the requested media by the first user]; and the record being used by the second user to provide one or both of services and/or incentives to the first user.” Instead, Figure 3 of Lu merely shows PVRs 200, 200A, 200B, TV head-ends 306, 308, an EPG server 304, the Internet 302 and a display device 212. *See* Lu at Figure 3.

Further, Lu at column 10, lines 10-38 merely discusses the process of recording a show out of a broadcast area and sending it to a requesting site. *See id.* at column 10, lines 10-38. This passage of Lu does not describe, teach or suggest, however, any notification records, nor such records being used by one user to provide services and/or incentives to another user. Indeed, the Applicants respectfully submit that neither Barsness, nor Lu, alone or in combination with one another describe, teach or suggest “keeping a record of the notifying [the at least a second user of the consumption of the requested media by the first user]; and the record being

used by the second user to provide one or both of services and/or incentives to the first user.”
Thus, for at least this additional reason, the Applicants respectfully submit that the proposed combination of references does not render claim 10 unpatentable.

III. The Proposed Combination Of Barsness And Lu Does Not Render Independent Claim 11 Unpatentable

Claim 11 recites, in part, “sending a notification via a communication network if the pre-defined set of characteristics for the requested media matches the at least one media characteristic [associated with a user]; and refraining from sending a notification if the pre-defined set of characteristics for the requested media does not match the at least one media characteristic [associated with a user].” The Applicants respectfully submit that the proposed combination of Brasness and Lu does not render claims 11-15 unpatentable for at least the reasons discussed above with respect to claim 1.

IV. The Proposed Combination Of Barsness And Lu Does Not Render Independent Claim 16 Unpatentable

Claim 16 recites, in part, “server software ... notifies, via a communication network, the associated second network address if the at least one media characteristic matches the at least one pre-defined characteristic.” The Applicants respectfully submit that the proposed combination of Brasness and Lu does not render claims 16-23 unpatentable for at least the reasons discussed above.

V. New Claims 24-38

New claims 24-38 have been added. The Applicants respectfully submit that the proposed combination of Brasness and Lu does not render these claims unpatentable for at least the reasons discussed above.

The fee for these new claims is calculated as follows:

15 new claims X \$50/claim = \$750

2 new independent claims X \$210/claim = \$420

TOTAL = \$1,170

VI. Conclusion

In general, the Office Action makes various statements regarding claims 1-23 and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully request reconsideration of the claim rejections for at least the reasons discussed above. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees, including the \$1,170 for new claims 24-38, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: January 10, 2008

MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100

/Joseph M. Butscher/
Joseph M. Butscher
Registration No. 48,326
Attorney for Applicants